

Application No. 09/636,286

RD-27791

REMARKS

Claim 12 is canceled and claims 1, 19 and 23 are amended by this Amendment. Basis for amendment is found in dependent claims and in the specification paragraphs [0005] and [0031] to [0032].

Claims 1 to 11, 13 to 20, 22 to 31 and 46 to 59 are pending.

The December 3, 2003 Final Rejection rejected claims 1 to 20, 22 to 31 and 46 to 59 under 35 U.S.C. §102(a) over Nielsen.

I CLAIMS 1 TO 11, 13 TO 20 AND 22 TO 31

Claims 1 to 11 and 13 to 18 are amended to a system that comprises "an elongation testing device, solvent exposure testing device, exposure to fluid testing device" or "hydrolytic testing device." Claims 19 to 20 and 22 to 32 are amended to a method of applying 'an abrasion test, an elongation test, solvent exposure test, exposure to fluid test" or "a hydrolytic test."

Nielsen Example 3 discloses a heating test. Nielsen does not teach or suggest a system that comprises "an elongation testing device, solvent exposure testing device, exposure to fluid testing device" or "hydrolytic testing device" or a method of applying 'an abrasion test, an elongation test, solvent exposure test, exposure to fluid test" or "a hydrolytic test." The rejection of claims 1 to 20 and 22 to 32 under 35 U.S.C. §102(a) over Nielsen should be withdrawn.

II. CLAIMS 46 TO 59

The December 3, 2003 Final Rejection also rejected claims 45 to 59 under 35 U.S.C. §102(a) over Nielsen.

A difference between the invention and Nielsen is that the invention creates a combinatorial library of "test results" from a variety of tests. The invention provides a substrate of material and then applies a variety of test conditions to create a substrate with a spatially defined array that reflects the variety of test results. Nielsen synthesizes

Application No. 09/636,286

RD-27791

a variety of products that are then tested to identify the products or their properties. No "test results" array is formed.

Claims 45 to 59 claim a method of testing and interrogating the results of the testing. The method includes a step of "applying varying testing conditions across a substrate to form a pattern of test results." The Final Rejection states that "Nielsen teaches that "testing conditions are varied across the substrate as in Col. 13 where each row of the array receives a different compound quantity in transition temperature test." However, a "different compound quantity" is a different composition not a step of "varying testing conditions." Nielsen col. 3 merely represents the prior art. Nielsen does not teach or suggest "applying varying testing conditions across a substrate to form a pattern of test results" (claims 46 to 59). Nielsen merely teaches the prior art method of synthesizing a variety of products that are then tested to identify the products or their properties, the testing done without forming a "test result" array..

"A claim is anticipated [under 35 U.S.C. §102(a)] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Nielsen does not teach or suggest a step of "applying varying testing conditions across a substrate to form a pattern of test results." The rejection of claims 45 to 59 under 35 U.S.C. §102(a) over Nielsen should be withdrawn.

III. CLAIMS 5 TO 6, 26 TO 27 AND 49 TO 50

Claims 5 to 6 claim a system "wherein the substrate" or "the coating" "exhibits inherent luminescence" and claims 26 to 27 and 49 to 50 claim methods with a substrate or coating that exhibits "inherent luminescence." The PTO acknowledges that the Nielsen substrates and coatings do not exhibit "inherently luminescence." December 3, 2003 Final Rejection, page 4. However, the PTO argues "[t]his teaching by Nielsen (Col. 6 Lines 9-17), while away from the embodiment claimed by the applicant, is valid under

Application No. 09/636,286

RD-27791

35 USC 102(a) because it is still a teaching of the claimed subject matter." December 3, 2003 Final Rejection, page 4.

First, the PTO characterization of the Nielsen col. 6, lines 9 to 17 teaching is incorrect. Nielsen col. 6, lines 9 to 17 states:

Finally, this invention enables the screening of materials on a wide number of different substrates, or in the presence of other components or materials without interference. This is because the substrate does not substantially interfere with the measurement of the materials thereon, using the methods of the present invention. By contrast, calorimetry generally loses sensitivity when other large objects (or objects having relatively high heat capacities) are included in the DSC sample.

This disclosure makes no mention and does not amount to any suggestion of luminescence.

Furthermore, to any extent that the PTO interprets the disclosure as a "teaching away" of luminescence, the PTO conclusion from this interpretation is an incorrect statement of the law that is diametrically opposed to correct law. A "teaching away" is *not* a teaching of an invention for any anticipatory purpose including a 35 U.S.C. 102(a) rejection. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) and MPEP §2141.02, last section.

Nielsen does not teach or suggest any "substrate" or "coating" that "exhibits inherent luminescence." The rejection of claims 5 to 6, 26 to 27 and 49 to 50 under 35 U.S.C. §102(a) over Nielsen must be withdrawn.

IV. CLAIMS 10 and 54

Claim 10 claims a system with a "thin film or plaque" "substrate" and claim 54 claims a method with a "substrate comprises a deposited coating that comprises a film." Nielsen does not teach or suggest a "thin film or plaque" "substrate" or a "substrate" that "comprises a deposited coating that comprises a film." The PTO refers to Nielsen col. 6, lines 44 to 60 and col. 7, lines 45 to 65. However, the only "thin film" Nielsen teaching including the col. 6, lines 44 to 60 and col. 7, lines 45 to 65 disclosure, relates to the

Application No. 09/636,286

RD-27791

applied array, not the substrate. The rejection of claims 5 to 6, 26 to 27 and 49 to 50 under 35 U.S.C. §102(a) over Nielsen must be withdrawn.

V. PREMATURE FINAL REJECTION

The office action is a premature final rejection. The PTO has not examined claim 47. Claim 47 claims a method comprising applying varying testing conditions to form a pattern of test results with intermittent untested reference spacings and "detecting radiation scattered from the pattern of test results *with the spacings*" (emphasis added).

The claim 47 limitation is important. As pointed out in the specification:

[0005] This invention provides methodology for the measurement of both low and high levels of scattered radiation produced by decorative and barrier coatings. Measurements of low levels of scattered radiation are especially important for coatings such as those used in automotive applications. The method is based on the illumination of a coating sample with an electromagnetic radiation source and collection of only a portion of the radiation scattered from the coating. Good correlation has been found between the data obtained via the practice of this invention and such data obtained via more cumbersome and inherently limited methodology such as that set forth in ASTM D 1003, and other tests. Through the practice of the invention, a large number of coating samples, as in an array, may be analyzed for their optical quality, *i.e.*, principally haze, either after coating and curing, and/or after subjecting such coatings samples to elongation stresses *and/or* abrasion and hydrolytic stability testing. An advantage of this invention is that when analyzing an array, the substrate is used as a reference for comparison of the optical quality of the substrate to that of the coating sample. In such an array, the uncoated substrate areas between the individual members of the coating array or library may be utilized as internal standards. A further advantage is the capability to analyze the standards and various abraded coating regions to determine the relative performance of a member of the combinatorial array or library.

The claim 47 step of "detecting radiation scattered from the pattern of test results with the spacings" is a step in using the spacings as reference regions to gain the inventive advantage of an "internal standard." But the PTO has not examined "detecting radiation scattered from the pattern of test results with the spacings."

The MPEP 2271 states:

Application No. 09/636,286

RD-27791

.... The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal....

Further, 37 C.F.R. § 1.104 entitled "Nature of Examination" provides that "[t]he examiner's action will be complete as to all matters...."

The PTO has not addressed the claim 47 "detecting radiation scattered from the pattern of test results with the spacings" in a developed manner to enable the Applicant to judge the advisability of an appeal. Indeed, the PTO has not addressed the claim 47 "detecting radiation scattered from the pattern of test results with the spacings" in any manner. The Final Rejection is incomplete and should be withdrawn and claim 47 examined and allowed or another office action issued to address claim 47 and restarting the period for response.

In this respect, Applicants include with this Amendment, an MPEP 706.07(c) AND MPEP 706.07(d) REQUEST TO WITHDRAW FINAL REJECTION addressed to the Primary Examiner.

VI. CONCLUSION

This Amendment should be entered. The Amendment only clarifies the claim 1 and claim 19 devices by substantially incorporating claim 12. The Amendment cancels claims thereby reducing the issues. Further the Final Rejection is an incorrect office action in failing to address the claim 47 limitation. Desirability of the Amendment became apparent only upon review of the pending Office Action. The Amendment places the application in condition for allowance. Thus, entry of the Amendment is requested under 37 CFR §1.116.

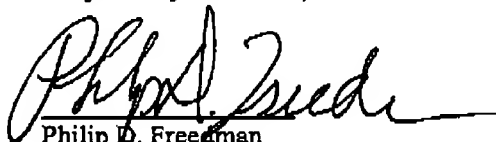
Application No. 09/636,286

RD-27791

In view of the foregoing amendments and remarks, reconsideration and allowance of claims 1 to 11, 13 to 20, 22 to 31 and 46 to 59 are respectfully requested.

Should the Examiner believe that any further action is necessary in order to place this application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Philip D. Freedman
Reg. No. 24,163
Philip D. Freedman PC
Customer Number 25101
P.O. Box 19076
Alexandria, Virginia 22320
(703) 706-5327
Email: tekesq@tekesq.com

Alexandria, Virginia
24 FEB, 2004

Application No. 09/854,718

RD-28013-2

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2881**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Radislav Alexandrovich POTYRAILO

Group: 2881

Application No.: 09/854,718

Examiner: David A. VANORE

Filed: May 14, 2001

For: **METHOD FOR THE RAPID DETERMINATION OF THE
OPTICAL QUALITY OF COMBINATORIAL LIBRARIES**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**MPEP 706.07(c) AND MPEP 706.07(d) REQUEST TO WITHDRAW FINAL
REJECTION**

Sir:

The Primary Examiner is requested to withdraw the December 3, 2003 Final Rejection for the following reasons:

1. Claims 1 to 11, 13 to 20, 22 to 31 and 46 to 59 are pending.
2. The December 3, 2003 Final Rejection rejected claims 1 to 20, 22 to 31 and 46 to 59 under 35 U.S.C. §102(a) over Nielsen.

**I. THE DECEMBER 3, 2003 OFFICE ACTION IS A PREMATURE
FINAL REJECTION**

3. Claim 47 claims a method comprising applying varying testing conditions to form a pattern of test results with intermittent untested reference spacings and "detecting radiation scattered from the pattern of test results *with the spacings*" (emphasis added).

4. Applicant's specification, paragraph [0005] points out the importance of

Application No. 09/854,718

RD-28013-2

this limitation:

[0005] This invention provides methodology for the measurement of both low and high levels of scattered radiation produced by decorative and barrier coatings. Measurements of low levels of scattered radiation are especially important for coatings such as those used in automotive applications. The method is based on the illumination of a coating sample with an electromagnetic radiation source and collection of only a portion of the radiation scattered from the coating. Good correlation has been found between the data obtained via the practice of this invention and such data obtained via more cumbersome and inherently limited methodology such as that set forth in ASTM D 1003, and other tests. Through the practice of the invention, a large number of coating samples, as in an array, may be analyzed for their optical quality, *i.e.*, principally haze, either after coating and curing, and/or after subjecting such coatings samples to elongation stresses *and/or* abrasion and hydrolytic stability testing. An advantage of this invention is that when analyzing an array, the substrate is used as a reference for comparison of the optical quality of the substrate to that of the coating sample. In such an array, the uncoated substrate areas between the individual members of the coating array or library may be utilized as internal standards. A further advantage is the capability to analyze the standards and various abraded coating regions to determine the relative performance of a member of the combinatorial array or library.

5. The claim 47 step of "detecting radiation scattered from the pattern of test results with the spacings" is a step in using the spacings as reference regions to gain the inventive advantage of an "internal standard."

6. However, the December 3, 2003 Final Rejection does not examine the claim 47 "detecting radiation scattered from the pattern of test results with the spacings" limitation.

7. The MPEP 2271 states:

.... The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal.....

8. The December 3, 2003 Final Rejection does not address claim 47 in a developed manner to enable the Applicant to judge the advisability of an appeal.

Application No. 09/854,718

RD-28013-2

9. Further, 37 C.F.R. § 1.104 entitled "Nature of Examination" provides that "[t]he examiner's action will be complete as to all matters...."

10. The Final Rejection is incomplete in failing to address the claim 47 "detecting radiation scattered from the pattern of test results with the spacings"

II. CONCLUSION

11. This Request to Withdraw the Final Rejection is filed pursuant to MPEP 706.07(c) and MPEP 706.07(d) as prerequisite to Petition to the Commissioner of Patents.

Applicants respectfully request the PTO to withdraw the December 3, 2003 Final Rejection, allow the application or reissue a non-final office action, restarting the period for response.

Respectfully submitted,



Philip D. Freedman
Reg. No. 24,163
Philip D. Freedman PC
Customer Number 25101
P.O. Box 19076
Alexandria, Virginia 22320
(703) 706-5327
Email: tekesq@tekesq.com

Alexandria, Virginia

LA FEQ, 2004